

## **REMARKS**

On January 20, 2011, an interview was conducted with the Examiner concerning the Declaration under 37 CFR 1.131 filed December 23, 2009, and the Examiner's position with respect thereto as set forth at pages 2- 3 of the Action.

The Examiner acknowledged that with respect to the five bullet pointed items at pages 2- 3 of the contention that it was necessary to demonstrate that the concept was "conceived prior to 03 February 2000" was a typographical error. The Examiner acknowledged that the statement was intended to read "conceived on or about 03 February 2000." No other agreement was reached.

### **A. Declaration Under 37 C.F.R. 1.131**

In Response to the Examiner's contention that "the statement and exhibits provided by the Applicant does not demonstrate that the concept of all the limitations in the claimed invention" were conceived prior to 03 February 2000 (or on or about February 3, 2000) as set forth at pages 2-3 of the Action, the Examiner's contention is not a correct statement of the applicable standard. Firstly, as set forth in MPEP 2138.04, conception has been defined as "the complete performance of the mental part of the inventive act" and it is the "formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice." Additionally, as provided in MPEP 2138.06 "the critical period for diligence for a first conceiver but second reducer begins not at the time of conception of the first conceiver but just prior to the entry in the field of the party who was first to reduce to practice and continues until the first conceiver reduces to practice."

Thus, although Applicant was diligent from the time between February 3 and February 29, 2000, as well as between February 29, 2000 and reduction to practice on April 20, 2000, since the prior art reference Keen.com has a publication date of February 29, 2000, so long as Applicant can demonstrate conception of the elements of the invention, as claimed prior to February 29, 2000 coupled with due diligence from just prior to February 29, 2000 until reduction to practice on April 20, 2000, Applicant will have demonstrated prior invention. In

other words, all of Applicant's activities between February 3, 2000 and February 23, 2000, which are the dates between which exhibits 11-14 were downloaded, must be considered to determine whether Applicant had conceived the invention prior to February 29, 2000 (and not on or about February 3, 2000 as contended by the Examiner). Paragraphs 9-20 of the Declaration filed December 23, 2009 describe the content of exhibits 11-14, and how their content relates to the claim elements. In this connection, it is respectfully submitted that such exhibits corroborate that the inventor was in possession of the inventive concept during the period between February 3, 2000 and February 23, 2000. Stated another way, the Declaration states as an unrebutted fact that the inventor conceived the invention on or about February 3, 2000, and documents downloaded by the inventor between February 3, 2000 and February 23, 2000 are corroborative evidence which show that the inventor was conducting research on how to implement the inventive concept.

As stated in paragraph 22 of the Inventor's Declaration filed December 23, 2009, between February 23, 2000 and April 20, 2000, the inventor reviewed the information which was downloaded between February 3, 2000 and February 23, 2000 for the purpose of determining how to best implement the invention. As a result, as stated in paragraph 23 of the Declaration, on April 20, 2000, the inventor developed six interactive web pages attached to the Declaration as Exhibits 3-8 to demonstrate actual reduction to practice of the invention as a form-based website where the email address of the receiver would be hidden from the user and where the email address of the user would be tracked for identification, further communication, and other purposes as set forth in paragraph 21 of the Declaration.

In view of the foregoing, Applicant respectfully submits that it has been demonstrated that the Declaration Under 37 C.F.R. 1.131 filed December 23, 2009 establishes that Applicant had conceived the invention prior to February 29, 2000, and was diligent in reducing the invention to practice from February 29, 2000 until actual reduction to practice on April 20, 2000. Therefore, Applicant respectfully submits that the cited reference Keen.com having a publication date of February 29, 2000 is not prior art.

## **B. Claim Rejections – 35 U.S.C. 112**

At page 4 of the Office Action, in Response to Arguments, regarding the rejection of the claims under 35 U.S.C. 112, first paragraph in a prior Action, and Applicant's response that the necessary disclosure may be found, for example, at paragraphs [0139]-[0152] and [0165], the Examiner now contends that "the disclosure filed by the applicant does not teach tracking of the user identification for a return text from the receiver (whose contact information is hidden) to whom said user sent a message, does not teach how the acknowledge message is delivered to the user (sender), how does the sender identify the recipient for the message (sic)."

In response, reference is made specifically to paragraphs [0149]-[0151] in which it is disclosed that

"a web based implementation is also preferable because in the preferred embodiment of the invention, the Merchant Intermediary encrypts or keeps secret from the Caller party the address or location of the Receiver party's account or address, formats the Caller party's communication or transmission, transacts or processes the Caller's payment or transfers rendered, transmits or directs the Caller's communication to the account of the Receiver, and accounts to and compensates the Receiver party for participating in the system or for downloading a Caller's transmitted communications all from one integrated system.

It can be easier for the Merchant Intermediary to encrypt a message or keep a Caller Parties address secret in a web-based implementation. For example, in a web-based implementation, a Caller party never has to even enter any address information into the message, it can be automatically and secretly entered so as to prevent the Caller party from knowing the Receiver party's mailbox, address, or account information."

That is, Applicant clearly discloses that utilizing a web-based implementation of the invention, a database can be pre-populated with all of the required data, by the Merchant Intermediary, so that the user can access the system, compose messages to be sent to a Receiver even though the contact information of the Receiver is not displayed since such information is stored in a database which the user cannot access, only the Merchant Intermediary.

### **C. Claim Rejections - 35 U.S.C. 112**

Regarding the rejection of the claims under 35 U.S.C. 112, first paragraph and second paragraph at pages 5 and 6 of the Action, it is Applicant's position that the foregoing explanation and the response to Office Action filed July 14, 2010 at page 11, and the response to Office Action filed December 23, 2009 at page 7 continuing to page 8 are fully responsive to the claim rejections under 35 U.S.C. 112, first paragraph and second paragraphs. For the Examiner's convenience, copies of these pages from the prior response are attached hereto. If the Examiner continues to maintain a rejection of the claims under 35 U.S.C. 112, it is requested that the Examiner specifically explain why the prior Responses at pages 11 and 7-8 do not satisfy and fully address the Examiner's concerns.

### **D. Claim Rejections - 35 U.S.C. 103**

Regarding the rejection of the claims under 35 U.S.C. 103 as being unpatentable over Cook in view of Keen.com (page 14 of the Action) such rejection relies upon Keen.com to disclose important aspects of the claims. However, as noted above, Keen.com is not prior art due to its publication date of February 29, 2000 which is after Applicant's date of conception followed by diligent reduction due practice (i.e., conception prior to February 29, 2000 with actual reduction to practice on April 20, 2000).

Thus, if Keen.com is removed as prior art, then the rejection of claims 21-46, as asserted at page 14 of the Action under 35 U.S.C. 103 as being unpatentable over Cook in view of Keen.com must be withdrawn since Keen.com is not prior art.

As to the rejection of claims 21-46 under 35 U.S.C. 103 as being unpatentable over MyEZmail in view of Shaw and Clark, Applicant responds as follows.

An important limitation of the claim is that text is transmitted from a user to a Receiver through the Intermediary facility for a fee paid by the user. In other words, a condition precedent for the text being transmitted is that the user must first pay a fee. If the user does not pay the fee, then nothing is transmitted. Although MyEZmail expressly discloses that the user does not pay any fee since the MyEZmail account is sponsor-funded (see for example the fifth paragraph of

MyEZmail), in order to positively recite that the fee paid by the user results in a benefit to the Receiver, Applicant has amended claim 21 to include most of the limitations of claim 26 and adds as a further limitation that the benefit received by the Receiver is a result of at least a portion of the fee paid by the user. Independent claims 31 and 39 are amended in a similar manner. Dependent claims 26, 36 and 44 are amended to remove limitations which were added to the corresponding independent claims.

As to Shaw, which the Examiner relies upon for its teaching relating to providing the sender selection capability for the sender to select a Recipient, Shaw, like MyEZmail, will always send the text to the recipient without first requiring that a fee be paid by the user, at least a portion of which results in a benefit to the Receiver.

The Examiner recognizes these limitations of MyEZmail and Shaw and cites Clark for its teaching of the capability and concept for a recipient charging a fee to senders. However, Clark merely discloses a mechanism whereby the Intermediary (Keen.com) initiates phone calls between two participants without divulging the phone number of either party. Keen.com as described by Clark contemplates only live conversations, and teaches away from utilizing text communications such as chat or email noting that:

“The web, on the other hand, offers a plethora of information in ways of communicating – through chat and email for instance – but the exchange is limited by the speed of their internet connection and rudimentary modes of expressing emotions...and Keen.com’s live answering community overcomes all of these limitations by allowing members to find people with specific information; access a real-time, consumer-based rating system to ensure quality; and connect with them over the phone, allowing a more personal, live and in-depth exchange...”

Thus, although Clark does teach communication from a user a Receiver for a fee paid by the user wherein contact information of the Receiver is hidden, Clark contains no mechanism nor does it have any need to track identification of the user for a return text and communication from the Receiver since Clark only contemplates live conversations. Thus, combining MyEZmail, Shaw and Clark, at best, would result in a system wherein a user pays a fee to engage in a live conversation with a Receiver. However, since Clark expressly teaches away from utilizing its

technique for chat and email, Applicant submits that a person skilled in the art would not look to the teachings of Clark to combine them with MyEZmail and Shaw to reach the present invention.

Regarding the rejection of claims 21-46 under 35 U.S.C. 103 as being unpatentable over Rochkind in view of Clark, Rochkind is relied upon by the Examiner to provide the same teachings as MyEZmail and Shaw as set forth in the above rejection. The Examiner again relies upon Clark for its teachings relating to transferring a fee from a user to a Recipient. However, for the reasons noted above, since Clark expressly teaches away from utilizing text or email, Applicant submits that a person skilled in the art would not be led to combine Rochkind with Clark to yield an invention which contains all of the limitations of claim 21, especially as now amended.

In view of the foregoing, Applicant submits that all of the outstanding grounds for rejection have been addressed, and independent claims 21, 31 and 39 amended to more clearly distinguish over the prior art of record. Since the remaining claims 22-30, 32-38 and 40-46 depend from independent claims 21, 31 and 39 respectively, Applicant submits that the claims pending for examination, namely claims 21-46 are now in condition for allowance, which early action is requested.

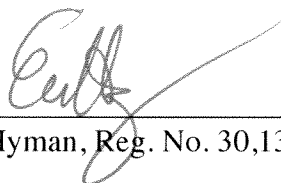
Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR, & ZAFMAN LLP

Dated:

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By:

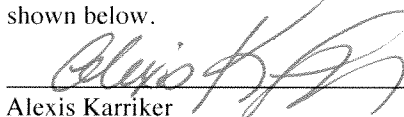


Eric S. Hyman, Reg. No. 30,139

1279 Oakmead Parkway  
Sunnyvale, CA 94085-4040  
Telephone (408) 720-8300  
Facsimile (408) 720-8383

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Alexis Karriker

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